

Drawing Amendments

Pursuant to the Examiner's request, a new replacement sheet, i.e. sheet 1 of 2, of formal drawings is submitted herewith. It adds the label of "Prior Art" to FIG. 1 as requested.

Remarks

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. These amendments to the claims constitute a bona fide attempt by applicants to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections. Claims 1, 2, 6 and 7 are pending.

Specification/Drawing objections:

The abstract is amended as suggested by the Examiner. A new sheet of formal drawings is submitted showing "Prior Art" as a label for FIG. 1 as requested by the Examiner. Hence, these objections have been overcome.

Claim Rejection – Double Patenting:

Claim 1-5 are provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-14 of copending application 09/815,854. The claims of the '854 application or of this application may change during prosecution such that this provisional rejection is no longer appropriate to maintain. Since this is only a provisional rejection at this time, it is appropriate to defer a further detailed response to this rejection until otherwise allowable subject matter is indicated for this application or the '854 application becomes a patent.

Claim Rejection - 35 U.S.C. §102:

Claims 1-5 are rejected under 35 U.S.C. §102 as being anticipated by Snellman, WO98/23108. This rejection is respectfully traversed. For explanatory purposes, applicants discuss herein one or more differences between the applied reference and the claimed invention with reference to one or more parts of the applied reference. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of the applied reference correspond to the claimed invention.

The following legal requirements are quotes from the MPEP 2131 and establish what is required to sustain a rejection under 35 U.S.C. §102.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

It is well-settled that there is no anticipation unless (1) all the same elements are (2) found in exactly the same situation and (3) are united in the same way to (4) perform the identical function. Since the applied reference is missing at least one element of each of applicants' independent claims, applicants respectfully submit that the claimed invention is not anticipated by the applied reference, as further discussed below.

Claim 1 is directed to a method for automatically updating a non-emergency telephone number stored in a wireless handset. It includes the steps of **comparing** a first non-emergency telephone number associated with a current location of the handset and a previously determined non-emergency telephone number, and **if the first non-emergency telephone number is different than the previous non-emergency telephone number, transmitting** a message containing the first non-emergency telephone number to the wireless handset where the message is a **command for the wireless handset to store in its memory the first non-emergency instead of the previous non-emergency telephone number for access by a user of the wireless handset.** This is not taught or suggested by Snellman.

There is no teaching or suggestion in Snellman that a comparison between a current non-emergency telephone number with a previously determined non-emergency telephone number serves as a controlling event determine whether the network will transmit the current non-emergency telephone number to the wireless handset to replace the stored previously determined non-emergency telephone number.

In accordance with Snellman:

For instance, should the number(s) of the local operator change, the user does not need to take any measures due to these changes, but the telephone unit will transparently and automatically adopt the new numbers as it enters the net, for instance by switching the telephone on. Snellman, page 8, the paragraph beginning "A possibility for this...."

Thus any new telephone numbers or services or any changes in the telephone numbers will be automatically transmitted into the memory means. Yet they can be done, for instance, each time the telephone is switched on or periodically and/or continuously over a certain period of time after a change has occurred and/or by a request from the user. Snellman, page 9, first paragraph.

Subsequent to these prior known operations [logging in to a new service area] the 'local network' will send back a specific telephone number to respective mobile telephone unit 1, which in turn will store said number to a random memory means thereof. Snellman, page 9, last paragraph - page 10, first paragraph.

In case mobile phone unit 1 in a vehicle enters into a new network (as shown by an arrow), the above procedure will be repeated. Thus the number store into the random memory will be changed from 9833922223 to 1324354657 as the vehicle enters the new net. Snellman, page 10, second paragraph.

It would be understood by one of ordinary skill of the art based on the teachings of Snellman that the updating of telephone numbers stored in the mobile handset occurs upon the network determining that the mobile handset has entered a new service area, or upon an existing service area updating the numbers to be utilized. That is, a previously determined and stored telephone number in the mobile handset is not utilized, or even described as being relevant to, the updating process. A previously stored telephone number is certainly not taught or suggested to be used as a basis for a comparison. Therefore, the "comparing" step of claim 1 of a previously stored telephone number with a currently determined telephone number, as well as the "transmitting" step based on the results of the comparison, are not taught or suggested by Snellman.

Although not controlling precedent with regard to the current examination of the subject application in the USPTO, a counterpart application now pending in the EPO having a claim substantially identical to claim 1 of this U. S. application has been determined to be novel and have inventive step. This determination was made in view of Snellman being specifically cited and considered as constituting the closest determined prior art reference. It is believed that this

determination further supports the distinctions pointed out above by applicant between the subject matter of claim 1 and Snellman.

It is respectfully requested that the 35 U.S.C. 102 rejection of claim 1 based on Snellman be withdrawn.

New independent apparatus claim 6 includes apparatus limitations substantially similar to the requirements of claim 1. Thus, claim 6 is believed to be allowable over Snellman for similar reasons explained above with regard to claim 1.

If no amendments are made to a claim(s), the examiner must not rely on any other teachings in the reference if the rejection is made final. If a newly cited reference is added, for reasons other than to support a prior common knowledge statement, as a new ground of rejection by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. MPEP 2144.03

Pursuant to MPEP 706.07(c), it would be inappropriate to make an Office Action final should new references be applied in support of a rejection of claim 1 since applicant has made no amendments to the claim to necessitate such a change of position.

In view of the above amendments and remarks, allowance of all pending claims is respectfully requested. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicants' attorney.

Respectfully submitted,



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